UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,643	07/20/2001	Andrew S. Kanter	0010-3	1842

25901 7590 06/09/2006

ERNEST D. BUFF
ERNEST D. BUFF AND ASSOCIATES, LLC.
231 SOMERVILLE ROAD
BEDMINSTER, NJ 07921

EXAMINER	
CARLSON, JEFFREY D	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 06/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/909,643	KANTER, ANDREW S.	
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 February 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8 and 10-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8 and 10-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the paper(s) filed 2/21/06.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 3-8, 10-15, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al (US6687737) in view of Goldhaber et al (US5855008).

Regarding claim 1, 8, 12, 15, Landsman et al teaches interstitial ads displayed to a user's browser from an Internet server. The ads are described as being displayed in browser popup windows which are shown to the user for a specified period of time (i.e. the duration of the ads) and the popup window is then removed upon completion. Landsman et al teaches that the AdDescriptor may specify that the user is NOT permitted to prematurely terminate (close) the ad displayed [32:5-46, fig 20]. The AdDescriptor file also specifies the duration of the ads [32:15-20, 37-40]. This is taken to provide a non-dismissible ad window that is temporarily shown for a pre-determined amount of time. Landsman et al also teaches that a log is kept regarding each ad impression [31:53-58]. Landsman et al also teaches targeting ads based on stored user profiles [21:13-20] – this is taken to provide the registered user database and ad

viewing history. When a user requests a subsequent webpage (via the user's ISP server(s)), the advertising display is triggered. Landsman et al does not teach compensation. Goldhaber et al teaches many embodiments whereby a registered computer user is compensated for viewing advertising [abstract]. The advertising can be targeted based on the registered user's demographics. The compensation can be routed to the user's registered account. It would have been obvious to one of ordinary skill at the time of the invention to have registered and compensated the ad-viewing users of Landsman et al's system so that users may be motivated to and may benefit from viewing online ads. Applicant's claim language that the user's received compensation comprises "credits for access time" is taken to merely require a user to receive "credits"; the "for access time" language is taken to represent future use outside of the current claim scope. Applicant has not claimed any particular steps or system structure which accomplishes redemption of the credits and the associated steps or system structure for providing the access time. Goldhaber et al teaches that the compensation may be cash or credit transferred to the user's computer or into her account [col 7 lines 51-54]. Goldhaber et al also teaches that the digital cash can have generic usefulness or can be restricted in its use [col 11 lines 25-31] in the manner of a coupon [col 10 lines 58-63]. Each of these forms of compensation (even the digital cash) provided by Goldhaber et al are taken to represent "credits" and therefore meet the claim language. Further, Goldhaber et al teaches that the rewarded compensation can be in turn used/redeemed for transactions [col 10 line 67 to col 11 line 7, col 12 lines 2-14, col 19 lines 63+]. Further still, the digital cash forwarded into the user's

computer *is capable* of being used for a transaction for "access time", even if done so outside the system/scope of Goldhaber et al. Because applicant has failed to claim any step/structure of redemption and the associated delivery of the access time, the prior art need not teach such. However, the mere *capability* for a rewarded user of Goldhaber et al to use her digital cash for access time can be taken to define Goldhaber et al's credits as credits "for access time". Even if the claims positively require redeeming the earned credits for "access time", Goldhaber et al teaches that the earned credits can in turn be redeemed for entertainment or other information the user desires to access. While Goldhaber et al does not appear to specify a time-element to these purchases, Official Notice is taken that it is notoriously well known to offer downloadable content (music, newspaper or magazine content, etc) through a paid subscription good for a finite access period (monthly, yearly). It would have been obvious to one of ordinary skill at the time of the invention to have used such earned credits of Goldhaber et al to purchase the content described through a subscription model rather than on a item or filesize basis as a more convenient/flexible payment arrangement.

Regarding claims 3, 6, 7, 11, 20, Landsman et al teaches that the AdDescriptor file can specify the size and location of the ad window [fig 20]. It would have been obvious to one of ordinary skill at the time of the invention to have displayed the window anywhere including the top of the user's screen as a design choice so that the ad is quite visible. Landsman et al teaches that ads are known to include hotlinks to the advertiser and advertiser web pages [3:40-46]. It would have been obvious to one of ordinary skill at the time of the invention to have provided URLs for the ad objects so

that a user may click on ads they are interested in. Official Notice is taken that it is well known for an advertiser to collect email/postal mailing addresses (demographic info) of interested prospective customer so that they can deliver more information about their products, services, sales promotions, etc. It would have been obvious to one of ordinary skill at the time of the invention to have provided fillable forms/windows on the advertiser's site in order to collect such information when user's request more information be sent to them. Further, it would have been obvious to one of ordinary skill at the time of the invention to have provided registration buttons and fillable forms/windows on the web site in order to collect registration information pursuant to Goldhaber et al's compensation. Goldhaber et al further discusses collection of personal data at registration time.

Regarding claims 4, 10, Landsman et al's plurality of ads to be shown and the ad queue are taken to provide a "series of ads" shown in an ad window.

Regarding claims 5, 14, the ad display is programmed to be delayed until the user transitions to a subsequent page. Further, Landsman et al teaches ads that sleep for a predetermined time period before they are shown again [32:25-33].

Regarding claim 13, when a user leaves a previous web site and triggers the ads, this action is taken as closing a computer program, the program being the HTML-programmed web site content.

4. Claims 2, 16-19 are r jected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al (US6687737) in view of Goldhaber et al (US5855008) and Radziewicz et al (US5854897).

Regarding claims 2, 16, 17, Radziewicz et al also teaches interstitial ads. Radziewicz et al teaches that the user's connection speed to the Internet can be measured and the speed results can be used to select a particular format for the ads [11:7-28]. It would have been obvious to one of ordinary skill at the time of the invention to have specified various ad formats in the AdDescriptor file so that the user can receive rich multimedia ads if their PC/connection could handle such files.

Regarding claims 18, 19, Official Notice is taken that using a wireless connection in order to access the Internet is well known. It would have been obvious to one of ordinary skill at the time of the invention for wireless users to have participated in the combined system so that they can enjoy the Internet wirelessly.

5. Claims 1, 3-8, 10-15, 20 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al (US6687737) in view of Klug et al (US5996007).

Regarding claims 1, 8, 12, 15, again Landsman et al does not teach compensation for users viewing ads. Klug et al also teaches interstitially presented ads and further teaches that users are rewarded for viewing the advertisements. Users are specifically rewarded with credits towards free Internet access time as an incentive for viewing a particular number of ads [col 3 lines 16-22, col 6 line 65 to col 7 line 4]. It

would have been obvious to one of ordinary skill at the time of the invention to have rewarded the ad viewers of Landsman et al with the access time credits of Klug et al.

Regarding claims 3, 6, 7, 11, 20, Landsman et al teaches that the AdDescriptor file can specify the size and location of the ad window [fig 20]. It would have been obvious to one of ordinary skill at the time of the invention to have displayed the window anywhere including the top of the user's screen as a design choice so that the ad is quite visible. Landsman et al teaches that ads are known to include hotlinks to the advertiser and advertiser web pages [3:40-46]. It would have been obvious to one of ordinary skill at the time of the invention to have provided URLs for the ad objects so that a user may click on ads they are interested in. Official Notice is taken that it is well known for an advertiser to collect email/postal mailing addresses (demographic info) of interested prospective customer so that they can deliver more information about their products, services, sales promotions, etc. It would have been obvious to one of ordinary skill at the time of the invention to have provided fillable forms/windows on the advertiser's site in order to collect such information when user's request more information be sent to them. Further, it would have been obvious to one of ordinary skill at the time of the invention to have provided registration buttons and fillable forms/windows on the web site in order to collect the required registration information pursuant to Klug et al's compensation. Klug et al further discusses collection of personal data at registration time.

Regarding claims 4, 10, Landsman et al's plurality of ads to be shown and the ad queue are taken to provide a "series of ads" shown in an ad window.

Regarding claims 5, 14, the ad display is programmed to be delayed until the user transitions to a subsequent page. Further, Landsman et al teaches ads that sleep for a predetermined time period before they are shown again [32:25-33].

Regarding claim 13, when a user leaves a previous web site and triggers the ads, this action is taken as closing a computer program, the program being the HTML-programmed web site content.

6. Claims 2, 16-19 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Landsman et al (US6687737) in view of Klug et al and Radziewicz et al (US5854897).

Regarding claims 2, 16, 17, Radziewicz et al also teaches interstitial ads. Radziewicz et al teaches that the user's connection speed to the Internet can be measured and the speed results can be used to select a particular format for the ads [11:7-28]. It would have been obvious to one of ordinary skill at the time of the invention to have specified various ad formats in the AdDescriptor file so that the user can receive rich multimedia ads if their PC/connection could handle such files.

Regarding claims 18, 19, Official Notice is taken that using a wireless connection in order to access the Internet is well known. It would have been obvious to one of ordinary skill at the time of the invention for wireless users to have participated in the combined system so that they can enjoy the Internet wirelessly.

Response to Argum nts

Applicant argues that a "credit" for something by definition represents a balance specifically for that thing. Examiner believes a "credit" represents an incremented "balance", regardless of whether it is a cash balance or other form of balance (points, miles, units, etc) or how it may be spent/redeemed. Webster's II New Riverside University Dictionary © 1988 provides a wide array of definitions for "credit", most notably: 'an amount placed by a bank at the disposal of a client' and 'the balance remaining in a person's account'. Neither of these definitions limit a credit with regard to how it may/must be spent. Examiner notes above that applicant's claim language that the user's received compensation comprises "credits for access time" is taken to merely require a user to receive "credits"; the "for access time" language is taken to represent future use outside of the current claim scope. Applicant attempts to define a balance of credits by how they can be subsequently used without claiming any particular steps or system structure accomplishing redemption of the credits and the associated steps or system structure for providing the access time in exchange. It is this missing claim language that would give meaning to the "for access time" phrase in a manner consistent with (most of) applicant's arguments. Please note however that where the instant specification provides support for credits, it merely states "credits for access time" [pg 10 line 19]. Examiner would consider it to be new matter if applicant amended the claims in an effort to require that the credits can ONLY be used for access time as there is no disclosure for this negative limitation (see MPEP 2173.05(i)). Further, the disclosed redeemable coupons provided as compensation [pg 10 line 19] are taken to

represent a form of credits for item(s) other than access times. Therefore, applicant's disclosure supports credits for access time as well as other items. Inasmuch as pertinent, examples are known where credits earmarked for a certain redemption purpose can be redeemed for other purposes, contrary to applicant's arguments. For example, frequent flyer miles have been capable of being used for various rewards such as free tickets, ticket discounts, seat upgrades, long distance calls, groceries, magazine subscriptions, etc.

Applicant further argues that claims 1-20 call for (i) the consumer views an advertisement, (ii) the advertiser compensates the consumer with credits for (Internet) access time; (iii) the consumer can only use the credits for (Internet) access time; and (iv) the consumer submits the credits to their online service provider to obtain additional access time. Examiner agrees completely with (i), agrees partially with (ii) (credits, yes – but not credits defined by how they may be used in the future), disagrees completely with (iii) (this would be new matter if claimed) and disagrees completely with (iv) (there is no step of redemption in the claims). Further, there is no support for any particular type of access time (Internet).

Applicant argues that Goldhaber et al's reward credits are different than the payments used by the user making a subsequent purchase. Most importantly, applicant is reminded that no steps of redemption are positively claimed. Nonetheless, Examiner disagrees. While Goldhaber et al describes the incoming credits as a payment 60(a) and the outgoing credits as a payment 60(b), these payments are simply representative of a crediting and debiting procedure – the currency (coupons, cash, credits) is the

same and the only difference is the direction of currency flow. Applicant further points to the unlinked sponsorship concept taught by Goldhaber et al as a point of distinction. Again this is not positively claimed. Yet, the unlinking described by Goldhaber et al is the ability to move from a mass-market approach where ads are universally embedded in delivered content to a flexible targeted system (as in the instant invention) where different user get different ads with the same content.

Applicant argues that claim 8 specifically requires that by the act of registering, the user is assured of compensation in contrast to Goldhaber et al. Perhaps this is an argument stemming from the *previous* amendment which called for users to surrender the option to decline ads upon registration. This is no longer required by the present claim language. Further, examiner is not using Goldhaber et al as a base reference, but rather Landsman et al which may be programmed to eliminate user control of the ads. Goldhaber et al is provided as a secondary teaching for compensation earned for viewing ads.

Applicant argues that the applied art does not teach registration means. Both Goldhaber et al and Klug et al which are relied upon for compensation teachings also include registration teachings.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc